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| 26161 7590 07/11/2007 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022 | | | EXAMINER BOCHNA, DAVID | |
| | | | ART UNIT 3679 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/501,802

Applicant(s)

SMAHL, JARMO

Examiner

David E. Bochna

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 21-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21, it is unclear how the outer layer can be in contact with but not secured to the inner most layer when the T section of the inner layer of the connection in fig. 1 or the bend and clamps 5 of the inner layer in fig. 2 would hold the outer layer and inner layer together, thereby securing the inner layer to the outer layer.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 21-23, 25-26, 29-31 and 37-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Burrowes.

In regard to claim 21, Burrowes discloses a pipe fitting for connecting at least two pipes, which pipe fitting comprises at least an innermost layer 12 and an outer layer 30 in such a way that the innermost layer is made of a material different from the outer layer, and that the innermost layer is made of plastic tolerating high temperatures (see col. 2, lines 41-49), and that the outer layer is formed of such a material that the outer layer is arranged to function as the provider of oxygen diffusion protection and/or the UV protector (intended use limitation), wherein the materials of the different layers are selected in such a way that the outer layer is in contact with but not secured (no cross-linking) to the innermost layer, such that the surfaces of the innermost layer and the outer layer are able to move relative to each other (the outer layer is elastomeric and the interior is plastic, so the outer layer could stretch and deform relative to the plastic interior).

In regard to claim 22, wherein the outer layer is arranged to function as the provider of chemical resistance (intended use limitation).

In regard to claim 23, wherein the outer layer is arranged to function as mechanical reinforcement (intended use limitation).

In regard to claim 25, the outer layer is made of PE (see col. 7, line 1).

In regard to claim 26, the walls of the innermost layer 11 are formed smooth.

In regard to claim 29, wherein the outer surface of the pipe fitting is of the same color as the at least two pipes 20 to be connected to the pipe fitting (please note that a change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

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In regard to claim 30, wherein the end of the outer layer 30 is arranged to function as the stop member of the at least two pipes 20 to be inserted into the pipe fitting.

In regard to claim 31, wherein the UV protection of the outer surface of the pipe fitting is intensified with metal (see col. 6, line 60-64) or mica pigment.

In regard to claim 37, wherein a support is intended to be used in connection with the pipe fitting, the support having a support collar whose width is substantially equal to the width of the compression collar and whose outer diameter is substantially equal to the outer diameter of the compression collar (this all intended use limitation language and claims not structural limitations relating to the pipe fitting recited in the preamble of the claim).

In regard to claim 38, wherein the pipe, the support, the pipe fitting and the compression collar are substantially of the same color (only the pipe fitting is being positively recited in the claim language, also note that a change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

In regard to claim 39, wherein in connection with the pipe fitting a plastic composite pipe having a plastic innermost layer and a metal layer outside it is intended to be used; the outer surface of the plastic composite pipe is of metal color, the color being provided by using a transparent extruded plastic material upon the metal layer, or in such a way that a surface is extruded upon the metal, which surface is colored using pearlescent, metal-colored or mica pigments (again, this is all intended use limitation, as only the pipe fitting is being positively recited in the preamble of the claim).

In regard to claim 40, wherein the outer layer is formed as a separate and replaceable part 30 (part 30 is separate from 12, and could be removed from 12 and a new piece 30 reformed over part 12).

5. Claims 21, 32 and 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Deters et al.

In regard to claim 21, Deters et al. discloses a pipe fitting for connecting at least two pipes, which pipe fitting comprises at least an innermost layer 25 and an outer layer 20 in such a way that the innermost layer is made of a material different from the outer layer, and that the innermost layer is made of plastic tolerating high temperatures, and that the outer layer is formed of such a material that the outer layer is arranged to function as the provider of oxygen diffusion protection and/or the UV protector (intended use limitations), wherein the materials of the different layers are selected in such a way that the outer layer is in contact with but not secured to the innermost layer (the outer layer is frangible and removable from the inner layer), such that the surfaces of the innermost layer and the outer layer are able to move relative to each other (see fig. 2 where 20 is removed to place the collar).

In regard to claim 32, wherein a compression collar (fig. 2) is arranged to be used to guarantee the connection between the pipe fitting 25 and at least one 12 of the at least two pipes 10, 12.

In regard to claim 34, the compression collar is the same color as the pipe fitting (please note that a change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)).

In regard to claim 35, the outer surface of either the compression collar or the pipe fitting is embossed 24a.

In regard to claim 36, the end of the compression collar on the side of one of the pipes is rounded.

1. Claims 21 and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Hallerstrom et al.

In regard to claim 21, Hallerstrom discloses a pipe fitting 13 for connecting at least two pipes, which pipe fitting comprises at least an innermost layer 13 and an outer layer 11 in such a way that the innermost layer 13 is made of a material different from the outer layer 11, and that the innermost layer is made of plastic tolerating high temperatures, and that the outer layer is formed of such a material that the outer layer is arranged to function as the UV protector (intended use limitations), wherein the materials of the different layers are selected in such a way that the outer layer is in contact (11b and 12b) with but not secured to the innermost layer, such that the surfaces of the innermost layer and the outer layer are able to move relative to each other.

In regard to claim 27, wherein there is an intermediate layer 12 between the innermost layer and the outer layer.

In regard to claim 28, wherein the intermediate layer 12 is a foamed plastic material layer.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burrowes.

In regard to claim 24, Burrowes discloses that the innermost layer is made out of a plastic material, but Burrowes does not disclose the exact material recited by the Applicant. However, it would have been obvious to one of ordinary skill in the art to make the innermost layer out of one of the recited materials because the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

4. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Deters et al. Deters et al. discloses a collar as described above, but does not disclose that the collar is the exact diameter of the fitting. However, it would have been obvious to one of ordinary skill in the art to make the collar the same diameter as the fitting because a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Response to Arguments

5. Applicant's arguments filed 6/15/07 have been fully considered but they are not persuasive. Applicant argues that Burrowes discloses an outer layer that is rigidly and tightly molded to the insert 11 and therefore does not disclose a fitting where the outer layer is "not secured" to the innermost layer.

The inner layer of Burrowes is made of steel, where the outer layer is EPDM rubber. There is no description of cross linking or fusing occurring between the steel and rubber

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surfaces. The rubber layer is formed around and attached to the steel insert. The rubber surface could be removed from the metal insert because they steel and rubber stay separate materials that are attached to one another. Therefore, Burrowes discloses an outer layer that is “not secured” to the inner layer in the same manner that the outer layer of the present invention is “not secured” to the inner layer. Additionally, it is unclear how the outer layer of the present invention can be considered “not secured” to the outer layer because the fittings of figs. 1 and 2 either have a T-pipe section or a bend which would hold the outer layer 3 onto the inner layer 2 thereby securing the inner and outer layers together.

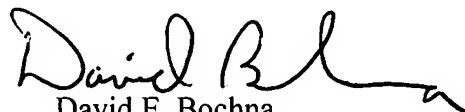
Applicant argues that Deters discloses an outer connector 20 molded onto an underlying inner connector 25, and that because the outer connector is molded onto the inner connector they are thereby “secured” to one another. The Examiner believes that the outer layer of Deters is no more “secured” to the inner layer than the outer layer to the inner layer of the present invention as the outer layer of Deters is frangible and separable from the outer surface of the inner layer 25. Similarly the outer layer of the present invention is secured to the inner layer in some fashion because the outer layer is not free to fall away from or slide off of the inner layer, as the outer layer surrounds the inner layer and is held in place either by the T-section of the fitting in fig. 1 or by the bend and clamps 5 in fig. 2.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Bochna whose telephone number is (571) 272-7078. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David E. Bochna
Primary Examiner
Art Unit 3679